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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Christian Volf Olgaard

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07/27/2006

VEDDER PRICE KAUFMAN & KAMMHOLZ  
222 N. LASALLE STREET  
CHICAGO, IL 60601

EXAMINER

MANIWANG, JOSEPH R

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/695,518	<b>Applicant(s)</b> OLGAARD ET AL.	
	<b>Examiner</b> Joseph R. Maniwang	<b>Art Unit</b> 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-14,17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14,17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/05/06 has been entered.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-6, 8-14, 17, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The phrase "direct and physical control" in independent claims 1, 9, and 17 is a relative term which renders the claim indefinite. The phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and

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one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The concept of "direct and physical control" is subjective and vague as to what would constitute such a situation, and the claim language does not limit this broad concept with any specific requirements. As the claims do not define the conditions for a user to have direct and physical control or a wireless device, the claims are unclear as to exactly what Applicant intends to claim as the invention.

***Claim Rejections - 35 USC § 102***

6. Claims 1-6, 8-14, and 17, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi (U.S. Pat. No. 6,633,759).

7. Regarding claims 1, 9, and 17, Kobayashi disclosed a method comprising submitting information about an interface client along a first wireless communication path to a user-driven wireless device in proximity of the interface client, wherein the wireless device is in direct and physical control of a user (see column 9, lines 40-45; column 13, lines 7-17); receiving content along a second wireless communication path from a remote source and conveying the content via the wireless device to the interface client along the first wireless communication path (see column 5, lines 3-14; column 13, line 62 through column 14, line 6; column 2, lines 37-39; column 4, lines 30-31); and displaying the content on a display of the interface client (see column 2, lines 39-40; column 4, line 32; column 13, lines 14-17; column 14, lines 9-11). Kobayashi disclosed a system comprising an interface client adapted for submitting information about the interface client (see column 4, line 21) along a first wireless communication path (see

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column 4, lines 24-25) to a wireless device (see column 4, line 23) in proximity of the interface client, the interface client having a displaying adapted for displaying content received by the interface client along the first wireless communication path (see column 4, lines 30-32); and the wireless device, adapted for receiving along the first wireless communication path the interface client information (see column 9, lines 40-49), receiving the content along a second wireless communication path from a remote source (see column 4, lines 39-47) and conveying the content to the interface client along the first wireless communication path (see column 4, lines 30-32), wherein one of the interface client, the wireless device and the remote source is adapted to format the content based on the submitted information from the interface client (see column 10, line 65 through column 11, line 3).

8. Regarding claims 2 and 10, Kobayashi disclosed receiving a signal from the wireless device when the wireless device is in proximity of the interface client prior to submitting the information about the interface client to the wireless device (see column 9, lines 34-36; column 12, lines 8-10, 54-60).

9. Regarding claims 3 and 11, Kobayashi disclosed the signal from the wireless device transmitted from the wireless device in response to a prior signal transmitted from the interface client (see column 2, lines 35-37; column 9, lines 27-28; column 12, lines 1-2, 52-53).

10. Regarding claims 4 and 12, Kobayashi disclosed the signal from the wireless device including information identifying a user of the wireless device (see column 9, lines 34-36).

11. Regarding claims 5 and 13, Kobayashi disclosed the information about the interface client including information about the capabilities of the interface client (see column 9, lines 40-45) and information about an input device of the interface client (see column 12, lines 25-27; column 13, lines 7-17).
12. Regarding claims 6, 14, and 19, Kobayashi disclosed the remote source as a server (see column 4, lines 44-47).
13. Regarding claims 8 and 20, Kobayashi disclosed the content formatted based on the submitted information about the interface client (see column 12, lines 22-32).

### ***Response to Arguments***

14. Applicant's arguments filed 03/06/06 have been fully considered but they are not persuasive.
15. Applicant traverses the rejection of claims 1-6, 8-14, 17, 19, and 20 under 35 U.S.C. 102(e) as being anticipated by Kobayashi (U.S. Pat. No. 6,633,759).
16. Regarding claim 1, Applicant asserts that Kobayashi does not anticipate the claim since the claim requires, among other things, that the wireless device be in the direct and physical control of a user and at the same time that the interface client display content. To this issue, Applicant notes that Kobayashi appears to be directed to two separate and unique embodiments of communicating between a mobile device and a PC. Applicant argues that the cellular phone of Kobayashi must be equated to both the wireless device and the interface client, as it is allegedly the only device in the direct and physical control of a user and the only device that displays content. Applicant

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similarly argues that the PC of Kobayashi's second embodiment must be equated to both the wireless device and the interface client. However, Examiner submits that this erroneously assumes that in the first embodiment, for example, the cellular phone is the interface client and that the PC does not display content. The fact that the cellular phone in the first embodiment displays content does not preclude the PC from doing so, and as such, it is not necessarily required that the cellular phone be considered the interface client instead of the PC. In fact, Examiner submits that Kobayashi clearly teaches that content can be received and displayed accordingly on the PC (see column 4, lines 30-32; Fig. 12). It is not the position of Examiner that the cellular phone or PC serves as both claimed elements in one device, as argued by Applicant. Instead, Examiner submits that the various aspects of Kobayashi's two preferred embodiments clearly teach the claimed elements presented. As acknowledged by Applicant, Kobayashi teaches in the first embodiment that a user may directly control and manipulate a cellular phone, and in the second embodiment that the PC can be under the direct and physical control of a user (see Remarks, p. 6-7). Examiner submits that these aspects of Kobayashi clearly read on the claim limitation reciting "wherein the wireless device is in direct and physical control of a user". Further to this point, Examiner notes that the breadth of the claim language allows for such an interpretation, since it is not necessarily required by the claims that any other claimed feature, such as the displaying of content, is a direct result of the direct and physical control of a user. In fact, the claim language in no way describes that any function, claimed or not, is at all related to the direct and physical control of the wireless device by a user, and it is

instead that the direct and physical control is a simple matter of fact with no claimed result.

17. Additionally, Although Applicant asserts that the two embodiments disclosed by Kobayashi are separate and unrelated, Examiner submits that as outlined in MPEP § 2123, patents are relevant as prior art for all they contain:

“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). (emphasis added)

Therefore, Examiner submits that Kobayashi clearly teaches in all disclosed embodiments both the wireless device and the interface client, where the wireless device is in direct and physical control of a user as claimed.

18. Regarding claim 9, Applicant asserts that Kobayashi does not teach communication with a remote source (i.e., a server). However, Examiner submits that communication with a server can be clearly seen throughout the disclosure of

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Kobayashi (see column 4, lines 33-47; column 5, lines 3-7; column 13, line 62 through column 14, line 11; Fig. 12). Additionally, Examiner submits that Kobayashi clearly teaches the broad concepts of a second wireless path from the server (see column 14, lines 4-6) and conveying content to the interface client along the first wireless communication path (see column 4, lines 18-32; column 12, lines 8-16) as claimed.

Further to this issue, Applicant asserts that Kobayashi does not teach formatting content for display on an interface client based on the submitted information from the interface client, as Kobayashi does not disclose formatting content based on the submitted information, since no such information is submitted. However, Examiner submits that Kobayashi reads on the broad concept of submitting device information and using such information in formatting content for display, as Kobayashi disclosed submitting ID information during a link negotiation (see column 8, lines 31-42; column 9, lines 25-35). The ID information, for example, "confirms that the requesting party is the cellular phone 2 from the ID information contained in the link establish request" (see column 8, lines 35-37), which allows for the situation where "the personal computer engine 15 controls the baseband unit 10 in the wireless communication module 7, so that screen data equivalent to a screen showing a list of all kinds of software is sent to the cellular phone 2 by a wireless radio wave" (see column 8, lines 47-55). Clearly, the information ascertained from the ID information that the destination device is a cellular phone is used by the PC to generate (i.e., format) the radio wave containing the content information, thus reading on the broad concept of formatting content based on submitted information as claimed.

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19. Regarding claim 17, Applicant asserts that Kobayashi fails to teach a wireless device separate and distinct from the interface client. Examiner submits that this is clearly taught by Kobayashi, as argued above with respect to claim 1. Applicant further asserts that the first embodiment of Kobayashi fails to teach communication with a remote source. Examiner submits that this concept is clearly taught by Kobayashi, as argued above with respect to claim 9.

### ***Conclusion***

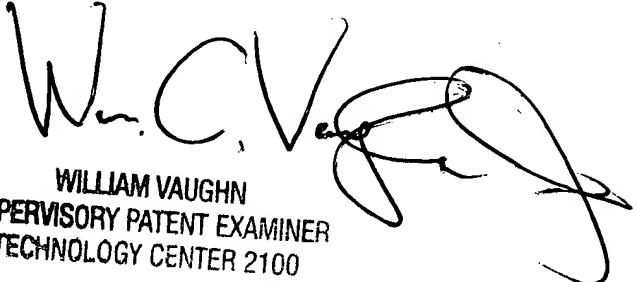
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

  
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